

## REMARKS

This is intended as a full and complete response to the Office Action dated June 15, 2004, having a shortened statutory period for response extended two months set to expire on November 15, 2004. Please reconsider the claims pending in the application for reasons discussed below.

### Specification:

In the specification, paragraphs [0008], [0010], [0013], [0017], [0022], [0033], [0034], [0035], [0036], [0037], [0038], [0039], [0040], [0041], [0044], [0045], [0047], [0049], [0050], and [0051] have been amended to correct minor editorial problems. Applicants submit that the proposed amendments do not introduce new matter. Paragraph [0017] stands objected to by the Examiner as erroneously including the word "conductive." Applicants have deleted this word and inserted the correct word "conductive." As the basis for this objection has been obviated, Applicants respectfully request withdrawal thereof.

### Drawings:

The drawings stand objected to under 37 C.F.R. § 1.83(a) for failure to show the claimed element "sensor." Applicants propose amendments to the drawings to correct minor editorial problems and to overcome the objection under 37 C.F.R. § 1.83(a). Applicants have submitted the proposed corrections marked in red on the attached copies of the original drawings filed in the application. The proposed corrections conform the drawings to the written description of the invention. The proposed amendment to Figure 3B rennumbers previously mislabeled element 150. The proposed amendments to Figure 4 entail insertion of omitted labels 110 and 105. The proposed amendments to Figures 5A and 5B entail insertion of omitted label 100 and a labeling correction for previously mislabeled element 175. The proposed amendment to Figures 6a and 6B entails insertion of omitted label 100. The proposed amendment to Figure 7A entails insertion of omitted label 217. The proposed amendment to Figure 9 entails insertion of omitted label 100. The proposed amendments to Figures 11A and 11B entail deletion of extraneous label 80 and insertion of previously omitted labels for sensor 98 and vibrator 99. The sensor is described in the specification in paragraphs [0037], [0045], [0046], [0048], and [0050]. The vibrator is described in the specification in paragraph [0051]. Accordingly, Applicants submit that the proposed amendments do not introduce new

**IN THE DRAWINGS:**

The attached sheets of drawings include changes to Figure 3B, Figure 4, Figure 5A, Figure 5B, Figure 6A, Figure 6B, Figure 7A, Figure 9, Figure 11A, and Figure 11B, and replace the original sheets including Figure 3B, Figure 4, Figure 5A, Figure 5B, Figure 6A, Figure 6B, Figure 7A, Figure 9, Figure 11A, and Figure 11B.

Attached are 7 sheets of formal drawings showing the abovementioned changes and a marked-up copy of the original sheets. Please amend and admit Figures 3B, 4, 5A, 5B, 6A, 6B, 7A, 9, 11A, and 11B as shown in the attached sheets.

**Attachment:            Replacement Sheets**  
**Annotated Sheets Showing Changes**

matter. As the basis for this objection has been obviated, Applicants respectfully request the rejection be withdrawn.

Claims 21-45 remain pending in the application and are shown above. Claims 21-45 stand rejected by the Examiner. Applicants have amended claims 22-30 to clarify the invention. Claims 21 and 31-45 have been canceled without prejudice. New base claim 46 and dependent claims 47-50 have been added to recite additional aspects of the invention. Applicant submits that no new matter has been entered. Applicants respectfully request the amendments be entered. Reconsideration of the rejected claims is requested for reasons presented below.

Claim Objections:

Claims 42 and 44 stand objected to for lacking antecedent basis for recitation of "the wellbore." Claims 42 and 44 have been amended to recite "a wellbore." As the basis for this objection has been obviated, Applicants respectfully request withdrawal thereof.

Claim Rejections Under 35 U.S.C. § 102

Claims 21, 27, 29-31, 37 and 39-45 stand rejected under 35 USC § 102(b) as being anticipated by U.S. patent 4,899,834 to *Weldon* on grounds that the cited reference discloses each element of Applicants' claimed invention. Specifically, the Examiner asserts that *Weldon* discloses a method of running an electrical transmitting tubular string into a wellbore, the string having a tool that changes shape disposed therein, and an automated downhole device disposed between a drill bit and the tool, wherein the downhole device is actuated via the string and an electrical transmission path across the tool.

Applicants respectfully traverse the rejection. Applicants have canceled claims 21, 31, 37 and 39-45, thereby obviating the basis of rejection of these claims. Claims 27 and 29-30 now depend from new independent claim 46. Further, the tool (drill collar assembly) 18 described by *Weldon* changes shape in a direction radial to the string (Fig. 8). In addition, any components of drill collar assembly 18 movable in an axial direction, e.g., intensifier 69, are hydraulically actuated (Fig. 5 and Column 9, Lines 26-40). Therefore, *Weldon* does not teach, show, or suggest an axially extendable signal conducting tool, having a flow path therethrough, located between the downhole device and an upper end of the tubular string, as recited in Applicants'

independent claim 46 and its dependent claims. Withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 22-25 and 32-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weldon* in view of U.S. patent 4,416,494 to *Watkins, et al.* Specifically, the Examiner asserts that *Weldon* discloses each element of Applicants' claimed invention except for a sensor located adjacent the drill bit, assertedly disclosed by *Watkins, et al.*

Applicants respectfully traverse the rejection. Claims 32-35 have been cancelled, thereby obviating the basis of the rejection. Regarding claims 22-25 (which depend from independent claim 46), as stated above, *Weldon* does not teach, show, or suggest each element of Applicants' base claim 46. In addition, *Watkins, et al.* do not teach the elements of Applicants' invention lacking in the previously cited reference. Therefore, the cited references, alone or in combination, do not teach, show, or suggest each element of Applicants' base claim or claims depending therefrom. Applicants respectfully request withdrawal of the rejection.

Claims 26, 28, 36, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Weldon* in view of U.S. patent 6,296,066 to *Terry, et al.* Specifically, the Examiner asserts that *Weldon* discloses each element of Applicants' claimed invention except for a thruster or stabilizer, assertedly disclosed by *Terry, et al.*

Applicants respectfully traverse the rejection. As stated above, *Weldon* does not teach, show, or suggest each element of Applicants' base claim 46. In addition, *Terry, et al.* do not teach the elements of Applicants' invention lacking in the previously cited reference. Therefore, the cited references, alone or in combination, do not teach, show, or suggest each element of Applicants' base claim or claims depending therefrom. Applicants respectfully request withdrawal of the rejection.

New claims 47-50 depend from new claim 46 and are allowable for at least the same reasons stated above with regards to claim 46.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe

that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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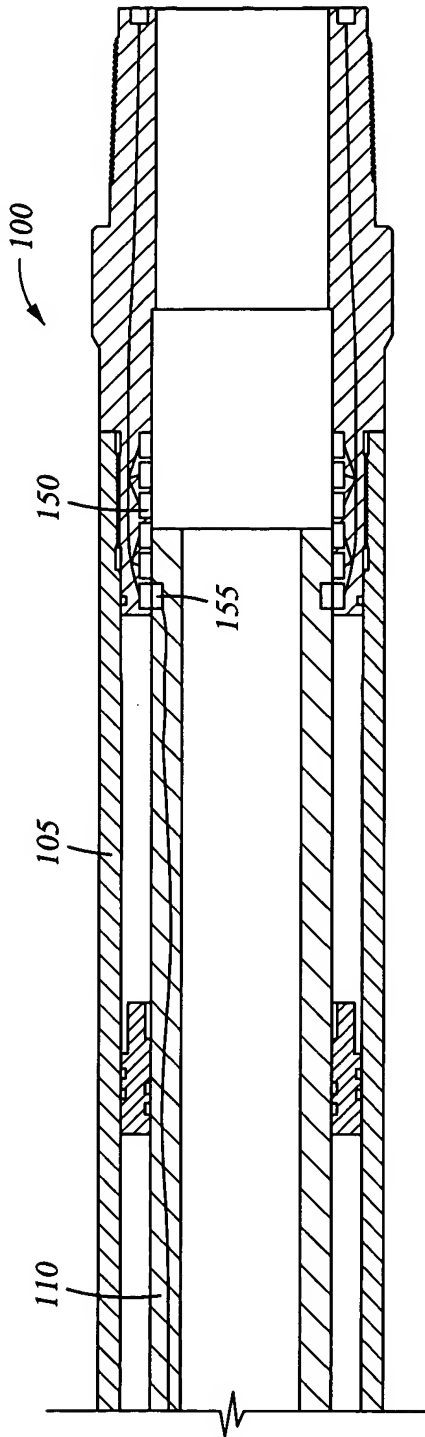


Fig. 3A

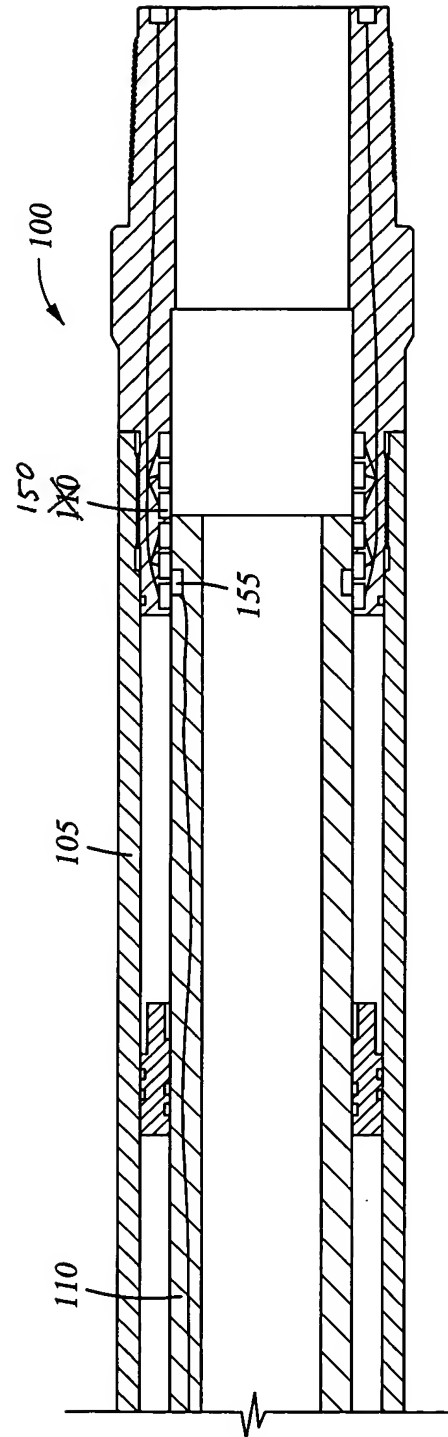
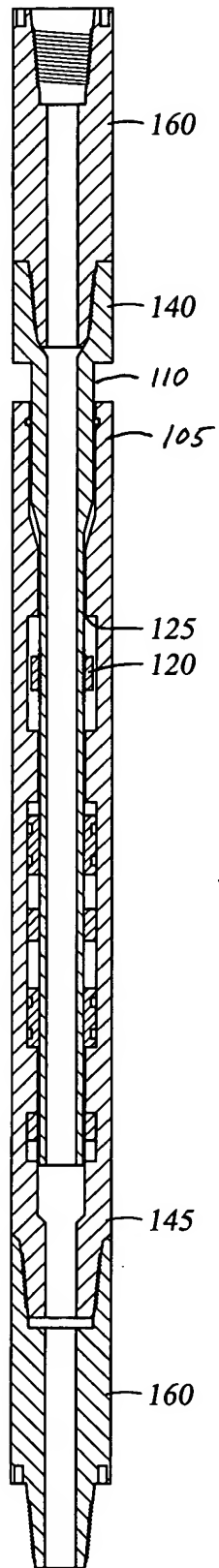


Fig. 3B

100 →

*Fig. 4*



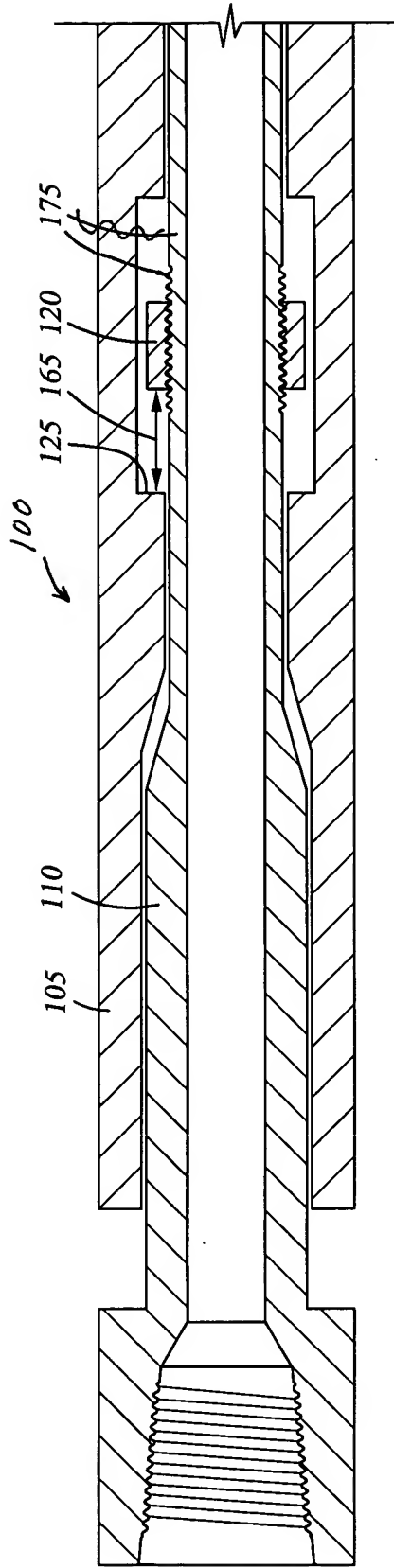


Fig. 5A

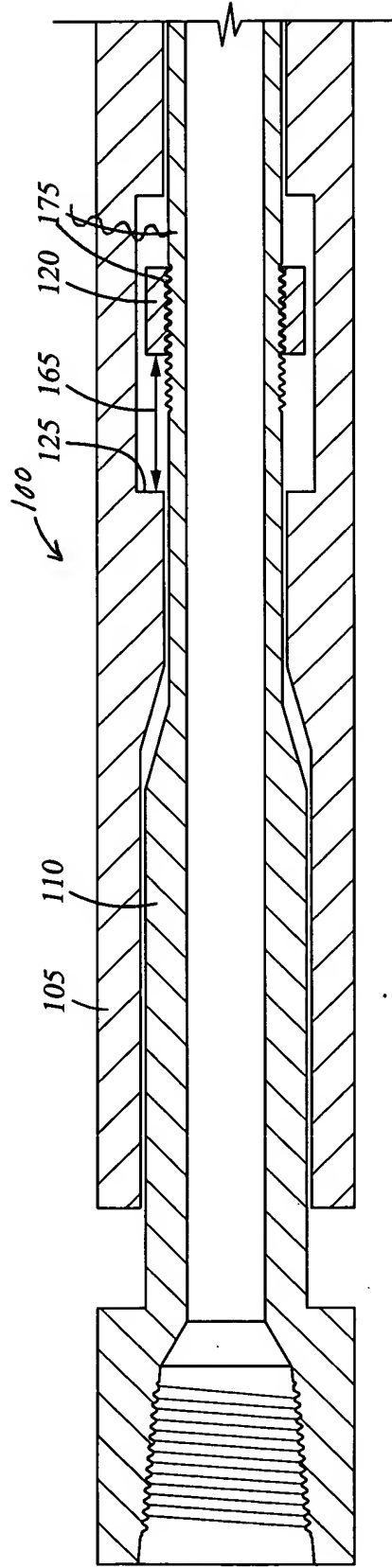


Fig. 5B



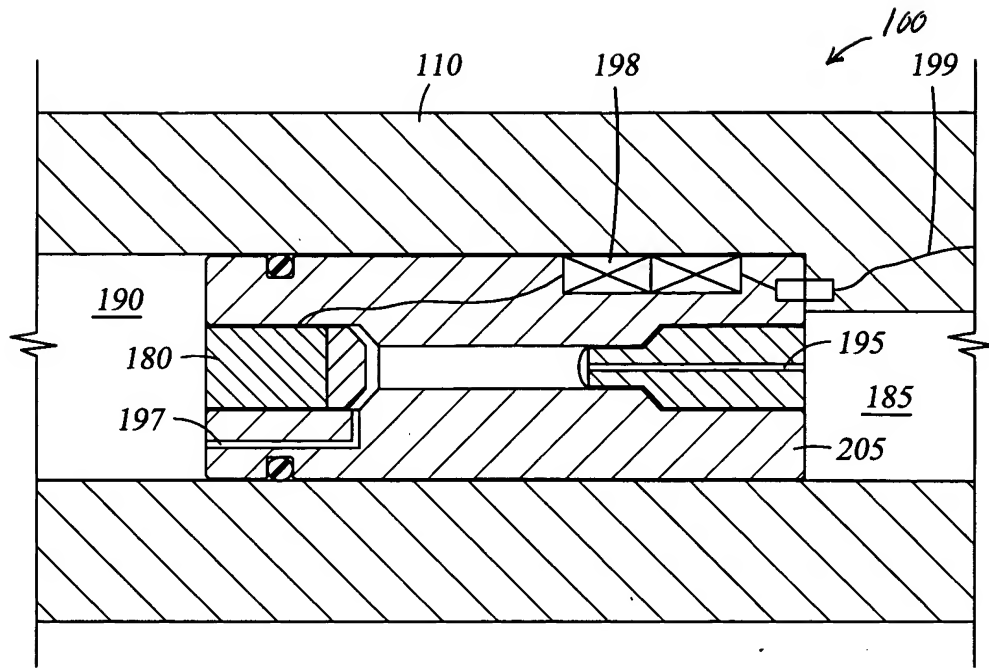


Fig. 6A

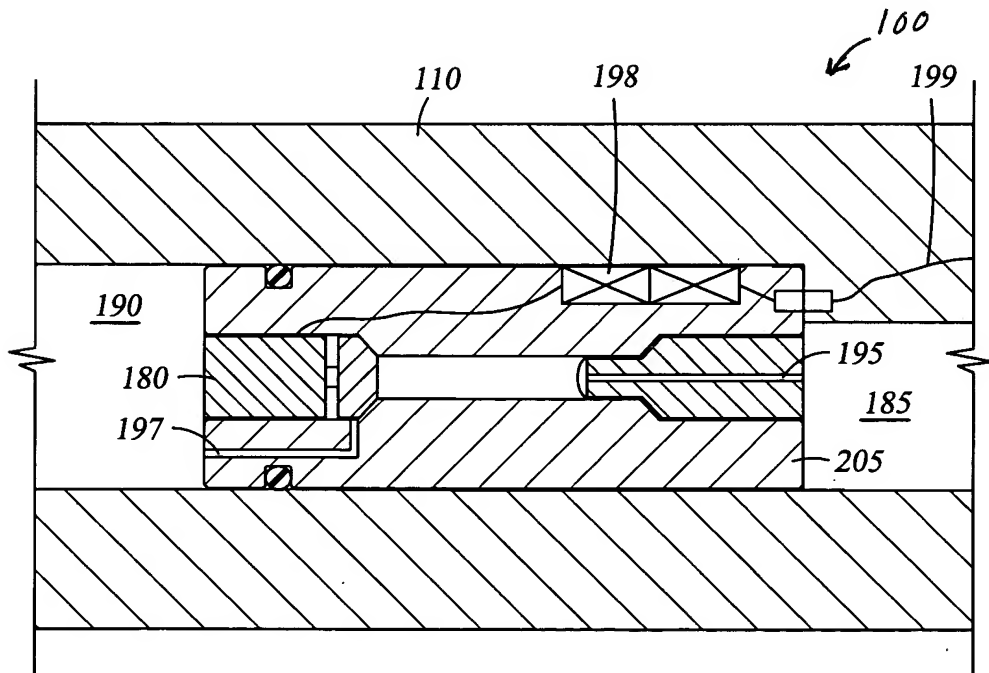


Fig. 6B

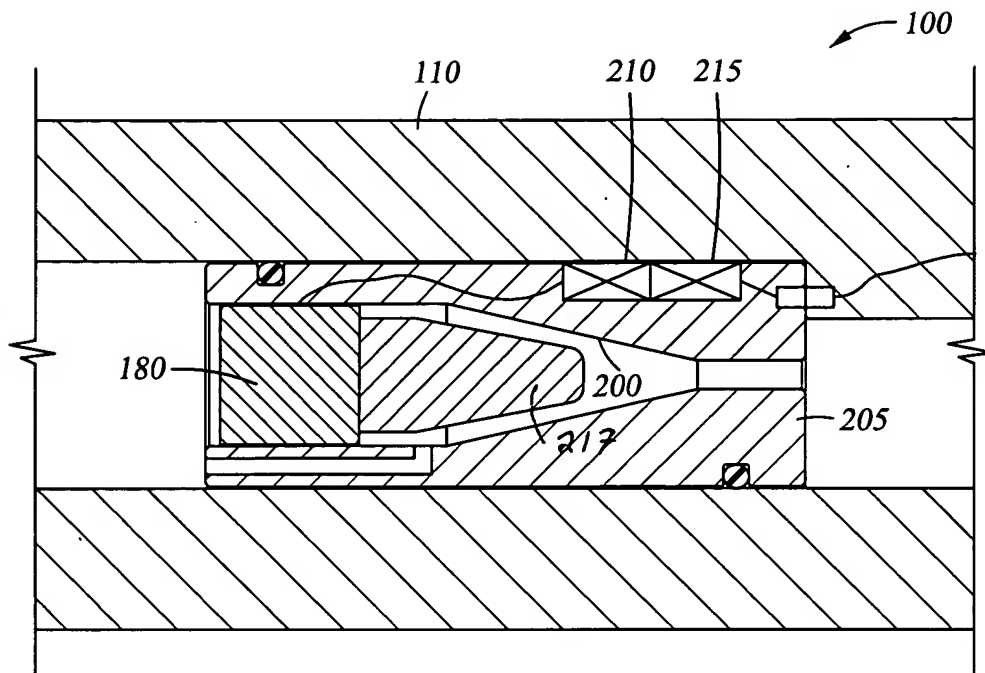


Fig. 7A

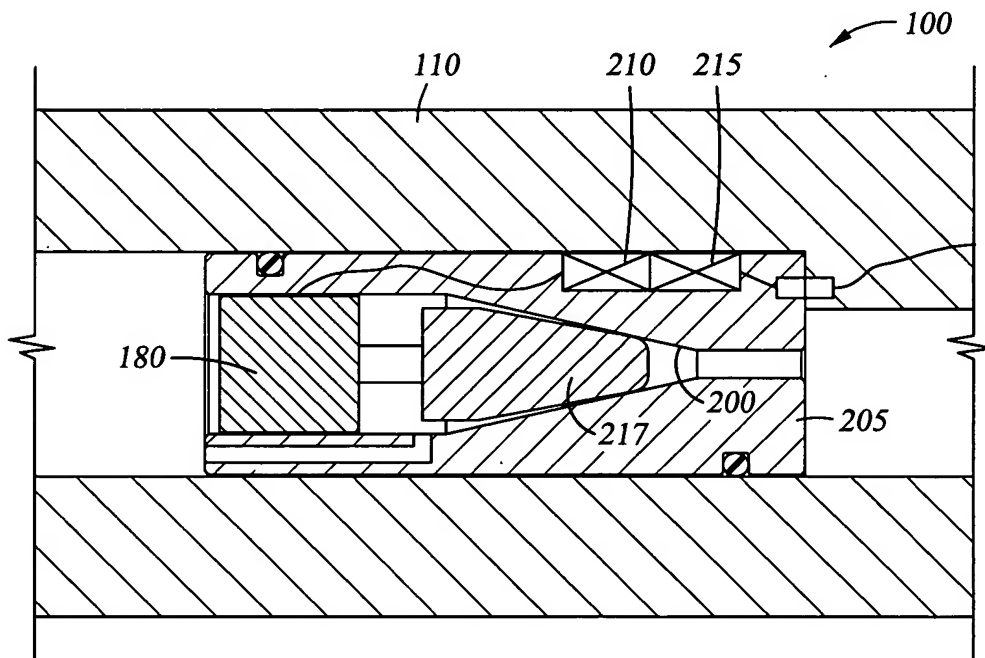
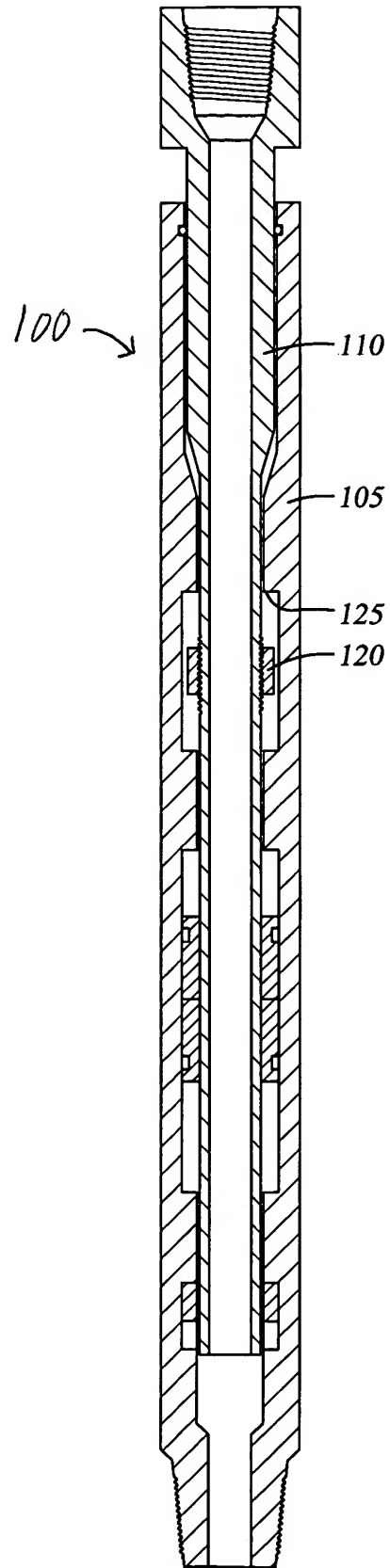


Fig. 7B

Fig. 9



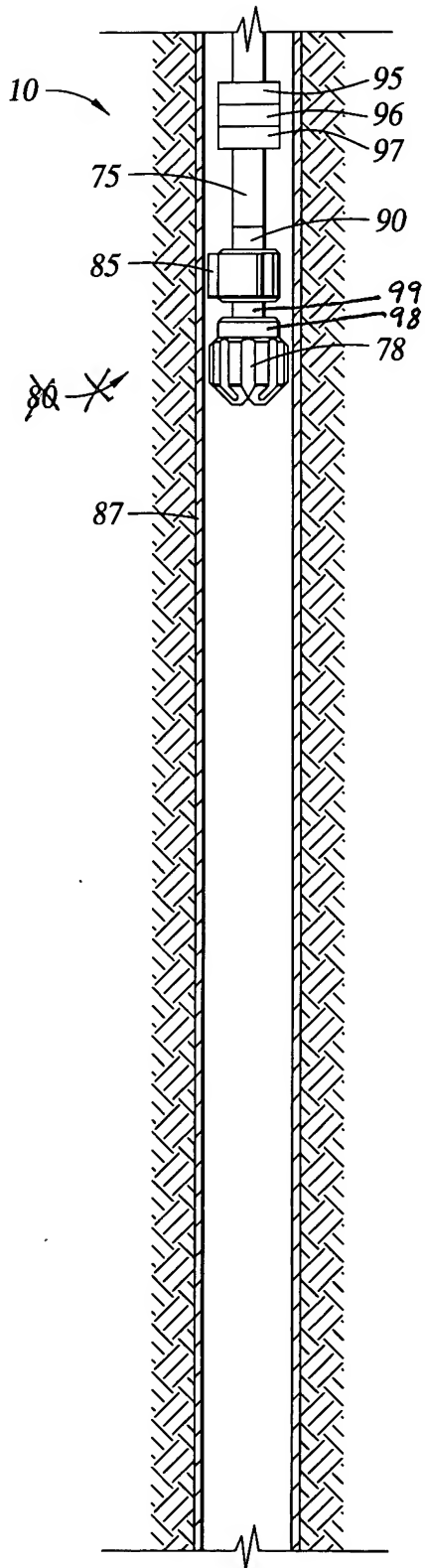


Fig. 11A

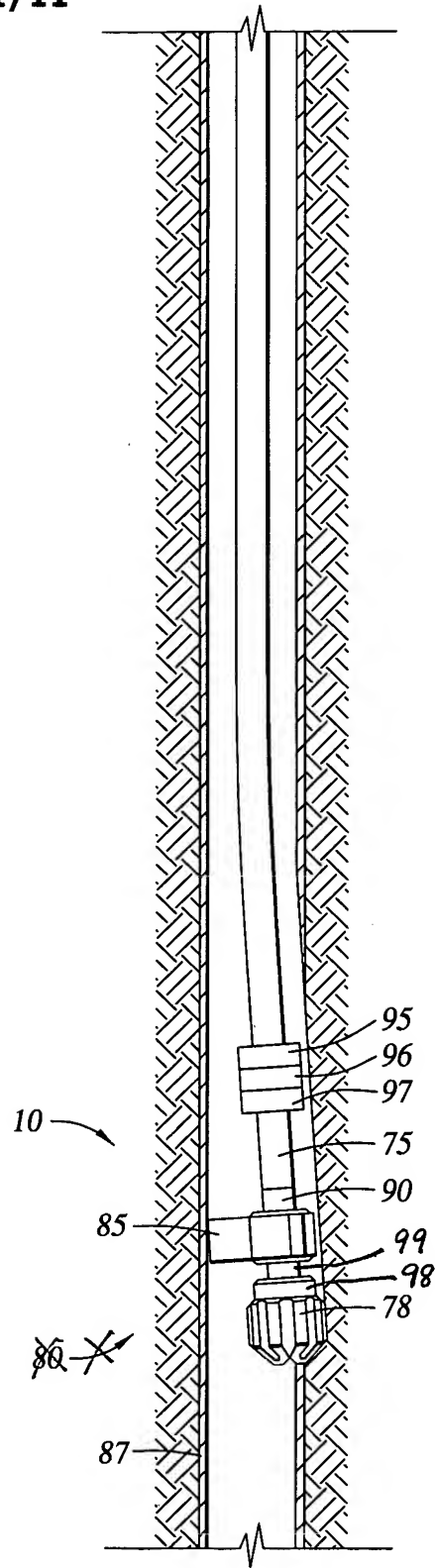


Fig. 11b